

REMARKS

Applicants thank the Examiner for the courtesies extended to their undersigned attorney and to David A. Lane, Jr., Esq., the attorney for the licensee of this technology, DePuy Spine, Inc., in a telephone interview held today. Applicants especially appreciate the Examiner's kind indication that he will withdraw the rejections of record based on this response and will begin the processing of this application for declaration of an interference with Carbone U.S. Patent No. 6,974,460, issued December 13, 2005.

With the entry of the amendment above, claims 6-10, 12, 13, 17, 18, 20-24, 26-35, 40-42, 61 and 62 will be pending in this application. Withdrawal of the rejection under 35 USC 112, second paragraph, on page 3 of the Action is respectfully requested in view of the amendment to claim 6.

Applicants submit herewith a terminal disclaimer to overcome the obviousness-type double patenting rejection, without acquiescing in the Examiner's stated basis for rejection.

Claims 6-10, 12, 13, 17, 18, 20-35, 40, 42, 61 and 62 stand rejected as anticipated by Morrison U.S. Patent No. 5,891,145. This rejection is respectfully traversed.

Applicants note that the same claims were rejected on Morrison in Carbone's application, so the arguments that were successful for Carbone should suffice here as well. Applicants attach for the Examiner's reference a copy of the Remarks section of the Amendment filed by Carbone on August 11, 2004, that resulted in the allowance of Carbone's claims copied by applicants.

In essence, Carbone argued, and applicants agree, that Morrison does not disclose that the seat is defined by the inner surface of the coupling element and that the head is in contact with the seat as claimed. The head of Morrison's bone screw 20 does not come into contact with the inner surface of the receiver member 30 or a seat defined by the inner surface of the receiver member. As shown in FIGS. 1 and 2 of Morrison, the head of the bone screw is spaced from an inner surface of receiver member 30 by inner wedge member 50 and outer wedge member 40. By contrast, the head of the bone screw as claimed comes into direct contact with the inner

surface of the coupling element. As a result, Morrison's head never comes "in contact with said seat of said coupling element" as required by claim 6 or the other independent claims in this application. Since Morrison does not teach or suggest this aspect of the invention as claimed in this application, this rejection should be withdrawn.

Claims 6-10, 12, 13, 17, 18, 20-35, 40, 42, 61 and 62 stand rejected as anticipated by Biedermann U.S. Patent No. 5,443,467. This rejection is respectfully traversed.

Biedermann's bone screw does not have the claimed coupling element having an inner surface defining a first bore coaxial with a first longitudinal axis and a second bore, coaxial with a second longitudinal axis, in which the first and second longitudinal axes intersect and are in communication with one another. The longitudinal axes of the central bore of the receiver member and of the second bore at the lower part of the receiver member according to Biedermann are the same, i.e., they are coaxial, and hence do not intersect. No person of ordinary skill in the art would have been taught or motivated by Biedermann to make the axes of the central bore of the receiver member and of the second bore at the lower end of the receiver member different and intersecting as required by the claims in this application. This rejection should be withdrawn.

Early action allowing claims 6-10, 12, 13, 17, 18, 20-24, 26-35, 40-42, 61 and 62 and passing this application to the Board of Patent Appeals and Interferences for declaration of an interference with the Carbone patent is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952, referencing Docket No. 564682000100.

Respectfully submitted,

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